1.   Claims 1-52 are pending in this application.
Reconsideration and further prosecution of the above-identified application are respectfully requested in view
of the discussion that follows.

Claims 1, 2, 5, 8, and 11-26 have been rejected under
35 U.S.C. §101 as being directed to non-statutory subject
matter.   In particular, the Examiner asserts that:

> For a process claim to pass muster, the recited
> process must somehow apply, involve, use, or advance
> the technological arts.   In the present case the
> independent claim 1 only recites an abstract idea.
> The recited steps of collecting sets of trade secret
> information, analyzing the collected sets, and
> generating a report does not involve, use, or advance
> the technological arts (i.e., computer, processor,
> electronically, etc.), since the steps could be
> performed using paper and pencil.

In response independent claims 1 and 27, and dependent
claims 28-52, have been further limited to a programmed
computer and a programmed computer method.   Support for
this limitation can be found throughout the specification.
The limitation of the claimed invention to a programmed
computer method and apparatus now clearly places the
claimed invention within the technological arts, and the
rejection should be withdrawn.

2.   Claims 1-52 have been rejected under 35 U.S.C 103(a)
as being unpatentable over Katz et al. (US 2003/0158745),
in view of Jacobsen et al. (USPN 6, 167, 397).   Katz et al.
discloses means of collecting and searching information
relating to intellectual capital, including trade secrets.

The examiner admits that Katz et al. does not disclose analyzing the collected sets of information to identify and eliminate redundancy. The examiner asserts that Jacobsen et al. discloses an algorithm for the clustering of documents employed as a post search analytical tool. As described in Jacobsen et al., this clustering is performed based upon an analysis of the content of the documents.

Examiner also states that "As per claim 2, Katz et al. disclose correlating among the sets of trade secret information having at least some redundant entries to identify sets of trade secret information that are related by redundancy and sets of trade secret information that are unrelated (i.e., the innovation query page 1200 allows the user to execute searches based upon various attributes of the abstract, paragraph 0050)" (Office Action of 2/24/05, page 4).

However, Katz et al. does not teach or suggest the discovery or handling of redundancy. The word redundancy or redundant does not appear anywhere in the Katz et al. disclosure or claims. What claim 2 does discuss is "matching entries". The matching of entries is discussed in paragraphs 53-57 of the disclosure and is described as being a process that identifies search results of queries (described in paragraphs 50-52 of the disclosure). The matching entries discussed in Katz et al. are not entries that match some other entry (i.e., that are redundant) but rather, they are entries that match the search criteria entered by the user.

This is made clear because the matching entries of claim 2 have their antecedent basis in claim 1. Claim 1 recites "entering a search criteria" and "searching . . . for matching entries". If one enters a search criteria,

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then the matching entries would certainly be the entries that match the search criteria, not each other. Further, even if the matching entries did match each other to some extent, there is not teaching or suggestion within Katz et al. that such de facto matching could or would be used to change the presentation or use of matching entries.

This is also made clear in paragraphs 50-57 of Katz et al. In paragraph 50-52, it is disclosed that queries can be made to search internal and/or external abstracts under any of a number of different criteria. In paragraphs 53-57, it is disclosed that any matching entries found are returned to the PC that made the query and displayed. These matching entries fulfill the search criteria selected and transmitted in paragraphs 50-52, they do not and are not intended to match any current abstract the user is working on.

The examples of FIGs. 8, 13 and 15 further clarify the point. In FIG. 8, the innovation entered into the system is a new thermal regulating coating. In FIG. 13, the search criteria are the words "taste, metal, removal" in the Abstract field, "remove metal aftertaste" in the Applications field, and "coating" in the General Classification field. In FIG. 15, the search results are displayed, providing four "matching entries": Metallic Taste Barrier, Metal Remover, Metal Coating, and Coating Remover. Note that these four matching entries do not match the abstract of FIG. 8, Thermal Regulating Coating. Nor are they matching (i.e. redundant) to each other. What these entries match is the search criteria entered in FIG. 13.

Thus, the user in claim 1 and the corresponding FIG. 13 is not querying the system for redundant innovations,

(those that match his innovation), that is, other thermal
regulating coatings. Instead, he is searching for
innovations that can be used together with his innovation,
to remove an apparent metal aftertaste that limits his
innovation.

The distinction is important. Katz et al. discloses a
system to allow innovators to document and share their
results, and view the results of others, through the use of
searchable abstracts. Nothing in Katz et al. addresses the
issue of multiple people entering the same innovation, or
any method (automated or manual) of finding or reducing any
resulting redundancy.

In contrast, applicant's invention assumes, in the
specific case of trade secrets, that there may not be a
single innovator. The innovator may not be the person who
enters the data. The entry of trade secret information by
a number of different people within an organization may
result in many duplicate entries for many of the trade
secrets. Applicant's invention teaches a method and a
system for the automated finding and reduction of the
resulting redundancy, which method and system is not taught
or suggested by Katz et al.

With regard to the application of Jacobsen et al. to
Katz et al., Katz et al. operates on abstracts about
intellectual capital, including trade secrets, whereas
Jacobsen et al. operates on the contents of documents that
contain information, possibly including trade secrets.
That is, Katz et al. works on a description of the
information, specifically an innovation, and Jacobsen et
al. works on a document containing the information, which
could be any information at all. Each entry in Katz et al.
is a description of an idea that may be contained in

multiple documents within the organization, whereas each entry in Jacobsen is a raw document without an external description and that may or may not contain any ideas.

Jacobsen et al. groups documents whose similarity of wording indicates that they may be related. In this regard, Jacobsen et al. explicitly states that the Jacobsen et al. "invention is directed to a method in which a cluster of documents is provided as a search result when the search query has not completely matched any documents, but, portions of the query are found to match a number of documents" (Jacobsen et al., col. 1, lines 8-12). However, since Jacobsen et al. does not deal with exact matches either among the search query or among the search results, Jacobsen et al. is clearly incapable of eliminating duplicates.

In addition, since Jacobsen et al. does not deal with exact matches, there would be no reason to eliminate documents. There would be no reason for Jacobsen et al. to eliminate documents because the Jacobsen et al. system would have no way to determine which document is being sought by a searcher instead of some closely related document.

In addition, there is no attempt under Jacobsen et al. to create abstracts, i.e., database entries each describing an idea, innovation, or trade secret. The resulting groupings may or may not each correspond to a single idea, innovation or trade secret, or to ideas, innovations or trade secrets in any way. It is only known that they may be related in some unspecified way. Jacobsen et al. is basically an electronic filing cabinet, sorting documents into folders.

Jacobsen et al. teaches grouping documents by the content of the search results. It does not teach finding redundancy among ideas or reducing that redundancy. It does not integrate the content of the documents so grouped into one document. It does not address redundancy among the documents in any way.

Since Jacobsen et al. merely clusters documents, there is no mechanism to eliminate duplicates. Since Katz et al. merely matches a search query with abstracts, Katz et al. also fails to provide any mechanism for eliminating duplicates. Since there is no mechanism to eliminate duplicates, the combination of Katz et al. and Jacobsen et al. fails to teach or suggest each and every claim limitation.

In addition, there is an even more compelling reason why the combination of Katz et al. and Jacobsen et al. is improper. The reason is that if Katz et al. were modified as suggested by the Examiner, Katz et al. would be rendered inoperative for its intended use.

In this regard, Katz et al. is directed to a search system that allows members to share research. The example shown in FIGs. 13 and 15 is a good example. If Katz et al. were modified to eliminate matching entries, then the members could not share files if they matched because those files would be eliminated.

In this regard, "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious" (In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Since the modification of Katz et al. would not allow Katz et al. to

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be used for its intended purpose of sharing information, there is no prima facie basis for obviousness.
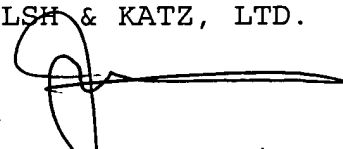
In summary, neither Katz et al. nor Jacobsen et al., nor the combination of Katz et al. and Jacobsen et al., teaches or suggests 1) finding redundancy in a set of descriptions of innovations/trade secrets, or 2) eliminating the redundancy through the integration of the redundant descriptions found in order to create a single non-redundant entry. Since the combination does not identify and eliminate redundancy, the combination could not also perform the step of "generating a report containing the non-redundant descriptive information about trade secrets of the organization". Since the combination fails to teach or suggest these claim elements, the rejections are believed to be improper and should be withdrawn.

3. Allowance of claims 1-52, as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, she is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,

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